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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,610

03/29/2004

Brett Allison Taylor

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WINSTON & STRAWN LLP  
PATENT DEPARTMENT  
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EXAMINER

PRONE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

12/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/810,610

**Applicant(s)**

TAYLOR, BRETT ALLISON

**Examiner**

CHRISTOPHER D. PRONE

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 20,30,32 and 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-29, 31, 33, 35-41 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

In response to the applicant's amendments claims 8, 12-19, 21-25, and 34 are rejoined and fully examined for patentability.

However claims 20 remains withdrawn for being directed to nonelected species F because it requires a dovetail connection engagement.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-29, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Gill et al USPN 6,113,637.

Gill discloses the same invention being a arthroplasty prosthesis comprising a first upper bone contact member 22, second lower bone contact member 24, a central articulation portion that allows for pivotal and translational movement of each contact independently (figures 1-12). Gill further discloses that the bone contact members each comprise fastener mount portions that engage the side of the vertebra comprising multiple holes 36 and 38 for screw fasteners 39 capable of penetrating into the implantation site.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

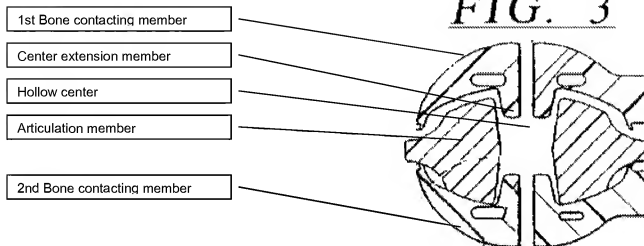
Claims 1-5, 9-10, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill in view of Bryan USPN 6,749,635 B1.

Gill discloses the invention substantially as claimed being described supra. However Gill fails to disclose the separate articulation member and corresponding structure.

Bryan discloses a disc prosthesis comprising upper and lower bone contact portions and an articulation member in between in the same field of endeavor for the purpose of allowing yet restricting and cushioning pivoting rotating and translational movement. See figure below for a detailed description of all the claimed components.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the articulation portion 30 and 64 with the articulation member and engagement configuration of Bryan in order to cushion and restrict the movement.

***FIG. 3***



Claims 6-8 are rejected under 35 U.S.C. 103 as being unpatentable over the combination of Gill and Bryan as applied to claims 1-5, 9-10, and 34 above and further in view of Grinberg et al USPN 6,770,095 B2.

The combination of Gill and Bryan disclose the invention substantially as claimed being described supra. However, the combination fails to disclose that the articulation member comprises upper and lower portions with corresponding posts and recesses.

Grinberg teaches the use of upper and lower portions that have corresponding recesses and protrusions shown in figures 1, 6, and 11-20 in the same field of endeavor for the purpose of allowing for translational movements and pivots.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the articulation member to comprise upper and lower components as taught by Grinberg in order to allow for an increased range or movement and rotations.

Claims 11-19, 21-22, 24-25, 40, and 46 are rejected under 35 U.S.C. 103 as being unpatentable over the combination of Gill, Bryan and Grinberg as applied to claims 6-8 above and further in view of Shima USPN 5,534,029.

The combination of Gill, Bryan, and Grinberg disclose the invention substantially as claimed being described supra. However, the combination fails to disclose a body prosthetic in between the contact members and a second articulation member.

Shima teaches the use of a vertebral implant comprising first and second contact members 4 and 5, a body portion 20, and two independent articulation components 7 and 25 in the same field of endeavor for the purpose of providing to spaced apart articulation members that can move and pivot separately.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Gill as modified by Bryan and Grinberg to include the body insert and have two separate articulation regions in order to mimic the natural movements allowed by the natural spine.

Claims 23 and 39 are rejected under 35 U.S.C. 103 as being unpatentable over the combination of Gill, Bryan, Grinberg, and Shima as applied to claims 11-19, 21-22, 24-25, 40, and 46 above and further in view of Hopf et al USPN 6,296,643 B1.

The combination of Gill, Bryan, Grinberg, and Shima disclose the invention substantially as claimed being described supra. However, the combination fails to disclose use of sutures and through holes.

Hopf discloses an arthroplasty prosthesis comprising a upper bone contact member 11, second lower bone contact member (bottom anchor figure 6a), a central articulation member (middle anchor figure 6a) that have comprise holes for receiving suture 38 in the same field of endeavor for the purpose of securing the components together.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Gill as modified by Bryan, Grinberg, and Shima to include the through holes and sutures as taught by Hopf.

Claims 36-38 and 41 are rejected under 35 U.S.C. 103 as being unpatentable over the combination of Gill, Bryan, Grinberg, and Shima as applied to claims 11-19, 21-22, 24-25, 40, and 46 above and further in view of Johnson et al 2002/0183761 A1.

The combination of Gill, Bryan, Grinberg, and Shima disclose the invention substantially as claimed being described supra. However, the combination fails to disclose use of materials including radiopaque, radiolucent, or drug delivery materials.

Johnson discloses an arthroplasty prosthesis comprising an upper bone contact member 198, lower bone contact member 200, a central articulation member (plates between members 198 and 200) that allow the vertebra to pivot and articulate, wherein the members are made from peek [0097], can comprise radiopaque markers [0097] and can deliver a biologically active substance to the implant site [0097].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Gill as modified by Bryan, Grinberg, and

Shima to include radiolucent, radiopaque, and drug delivery materials as taught by Johnson.

***Response to Arguments***

Applicant's arguments filed 9/17/08 have been fully considered but are moot in view of new rejections.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738